



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,581	05/10/2001	James L. Warmus	27600/M239A	6089

29471 7590 05/26/2004

MCCRACKEN & FRANK LLP
200 W. ADAMS STREET
SUITE 2150
CHICAGO, IL 60606

EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 05/26/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,581

Applicant(s)

WARMUS ET AL.

Examiner

Stephen S. Hong

Art Unit

2178

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 18.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Part III DETAILED ACTION

1. This action is responsive to communications: amendment filed on 3/11/04 and IDS filed on 2/4/04 and 3/8/04 to the application, filed on May 10, 2001, which is a Div of 08/802,337 filed 2/11/97, which is a C.P. of 08/478,397 filed 6/7/95, which is a C.P. of 08/724 filed 4/2/96.
2. In the amendment claims 14-26 are added. Accordingly, claims 1-26 are pending in the case. Claim 1 is an independent claim.
3. The rejection of Claims 1-13 under 35 U.S.C. 103(a) as being unpatentable over de Heus et al, U.S. Pat. No. 5,390,354, 2/95 in view of Nussbaum et al. has been withdrawn as necessitated the amendment.

Specification

4. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claim 1, the newly added limitation in step "(D)" states "generating page description ...of the first and second books." The previous step "(C)" only discusses that the content of the "first book" is determined. Thus, the step of generating "the second book" is indefinite, since it is unclear what this "second book" is in relation to the first book of the step "C". Dependent claims 2-13 are similarly rejected for fully incorporating the deficiency of claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Heus et al, U.S. Pat. No. 5,390,354, 2/95 in view of Nussbaum et al., U.S. Pat. No. 5,346,196, 9/94 and Fannin et al., U.S. Pat. No. 5,535,677, 7/96.

As per independent claim 1, de Heus teaches the claimed method of assembling a book including:

specifying pagination information including an indication of whether a page is to be selectively included in the book; determining whether the page is to be assembled into the book based on the pagination information; and generating page description language instructions for production of the book in accordance with the pagination information (col.3, lines 25 to col.4, line 14).

However, de Heus does not explicitly disclose that the total number of pages is to be assembled into the book is less than the initial first number of pages stored. With respect to the missing limitation, Nussbaum provides the following pertinent teaching. Nussbaum teaches a custom book assembly and biding system that different combination of pages to be selectively included in the book assembly (col.1, lines 50+). Nussbaum points out that the customizations can be based on various different factors including, demographic information, geographic information, etc. (col.2, lines 3+). Note that Nussbaum teaches a use of a digital "codes" that stores that which pages are to be incorporated into the specific book (col.3, lines 50-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used de Heus' printing system to the custom book assembly such as Nussbaum, since Nussbaum pointed out that the disclosed system allows the document to be assembled based on the specific customers or targets.

Furthermore, de Heus does not appear to be producing first and second books in a single press run. It appears from the teaching of de Heus and Nussbaum that each custom book may be generated by a separate press run. Nevertheless, Fannin teaches the method of generating a book using where a set of different custom books is generated in a single press run. Fannin teaches generating a check book (col.1, lines 35-42). Fannin teaches that in the prior art, different custom check books are generated in a separate press run (col.1, line 60+). Fannin improves the feature by allowing a single press run to print a two different set of check books using the invention (col.2, lines 35-57). Although Fannin's book is a simpler book than de Heus, Fannin does teach that the technique of using a single press run to generate more than one book was well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Fannin's feature into de

Heus and Nussbaum, since Fannin pointed out that using the single press run technique relieves “the added expense of preparing two separate plate...and [time] slowed by the need to swap the plates during the press run. (col.2, line 17+).”

As per dependent claims 3, 4, 6, 7 and 10-12, de Heus further teaches:

- analyzing press commands directed to production of the book to determine whether the page is to be assembled into the book (col.3, lines 25-60, “The final book layout... can be printed directly on output devices... us[ing] Adobe TM Postscript ...[or] non-Postscript”);

- the step of generating a pagination file having data representative of the pagination information (col.3, line 68, “commands are combined ...that can be interpreted...”);

- wherein the pagination information includes a specification of wherein the page should be forced to one of a right side and a left side of the book (col.6, lines 8-28);

- wherein the method further include delivering the page description language instructions to an electronic press to print the book (col.3, line 39, “form a complete page image may be implemented either in the Host Publishing system or in a Digital Graphics..);

- the step of generating page description language instructions further comprises the step of generating instructions for insertion of filler pages in accordance with pagination information (col.5, line 31-62).

As per dependent claim 2, de Heus does not explicitly disclose analyzing variable information areas of the page. Nevertheless, as Applicant points out in the background section of the present application (e.g, on page 2), it was extremely well known in the art to provide variable information areas in a page of a book. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made

to have included the step of analyzing the variable area in de Heus, since it would have allowed de Heus to process generating books that use the well known variable page processing techniques.

As per dependent claim 5, de Heus does not explicitly disclose that the pagination information includes an indication of a maximum number of pages for the book. Nevertheless, de Heus discloses including maximum display area per page, maximum filler, minimum filler (col.5, line 53+) and points out that the system recognizes the quantity of pages of the book (col.5, line 52). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have include the information of the maximum number of pages for the book, since de Heus suggested that the size limitation of the whole document must be determined by limiting other factors such as the filler page numbers.

As per dependent claims 8 and 9, although de Heus does not teaching using the barcode on the pages for the tracking information. The use of barcode for tracking document pages was extremely well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used the well known tracking means in the disclosed invention of multiple page document generation.

As per dependent claim 13, de Heus does not teach that the method include the step of providing a user interface for entry of the pagination information. Nevertheless, de Heus teaches the system in Figure 1 which accepts the pagination information from the Host interface. Since de Heus also teaches that the information is generated by the Host Publishing system (col.3, lines 25 +), it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have envisaged that the

host system be provided with a means for the operator to input the data including the pagination data.

Dependent claim 14 recites a step of further creating a second book using the same process of creating the initial book of claim 1. Although de Heus and Nussbaum do not explicitly disclose the step, Nussbaum suggested using the process to create a plurality of different custom books. Therefore, given the teaching of Nussbaum, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have created a second book, since a person of ordinary skill in the art would have appreciated that Nussbaum's invention was to provide the ability to create a plurality of customized books.

Dependent claims 15-26 recite substantially similar limitations as claims 2-13, respectively, and are similarly rejected under the same rationale.

Response to Arguments

8. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

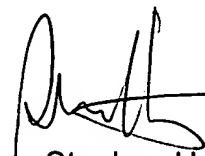
Art Unit: 2178

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Stephen Hong
Primary Examiner
Art Unit 2178
May 21, 2004